

Attorney Docket No.: 99.51  
PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Zecchino et al.

Serial No.: 09/995,358

Group Art Unit: 1615

Filed: 11/26/2001

Examiner: B. Fubara

For: Gelled Aqueous Cosmetic Compositions

**SUPPLEMENTAL APPELLANT'S BRIEF PURSUANT TO 37 CFR 41.37**

Commissioner of Patents

Attention: Board of Patent Appeals and Interferences

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

Appellants hereby submit an amended appeal brief to the Board of Patent Appeals and Interferences in response to a Notification of Non-Compliant Appeal Brief. The Appeal Brief submitted on February 28, 2005 is held to be noncompliant with rule 37 CFR 41.37, effective September 13, 2004. Specifically, the Notification indicated that the Appeal Brief is missing the Status of Claimed Subject Matter; Grounds of Rejection To Be Reviewed On Appeal; Evidence Appendix; and Related Proceedings Appendix.

The Applicants have amended the originally submitted the Appeal Brief to submit the missing sections/corrected headings to comply with 37 CFR 41.37. The due date for compliance is January 29, 2006. Therefore, the Applicants hereby submit a four month extension of time along with the Amended Appeal Brief.

## **APPEAL BRIEF**

### **REAL PARTY IN INTEREST**

The name of the real party in interest in this appeal is Color Access, Inc., the assignee of the application.

### **RELATED APPEALS AND INTERFERENCES**

There are no other appeals or interferences relating to the instant application that would directly affect, be directly affected by, or have a bearing of any kind on the Board's decision in this appeal that are known to Appellants.

### **STATUS OF THE CLAIMS**

Claims 1-21 are pending in this Application, and are included in this Appeal. Claims 1 and 12 were amended in a response dated October 20, 2003. Claims 1, 12 and 19 were further amended in an after final amendment dated July 30, 2004. A copy of all claims (1-21), pending in this Appeal, also is attached hereto.

### **STATUS OF AMENDMENTS**

An Amendment under 37 C.F.R. 1.116 was filed on July 30, 2004, but in the Advisory Action mailed August 24, 2004, it was stated that it was not considered for being in improper form. Specifically, the status of all the pending claims was not explicitly stated. All pending claims, a copy of which is attached hereto, are included in this appeal, as well as a copy of the Amendment.

### **SUMMARY OF CLAIMED SUBJECT MATTER**

The invention of independent claim 1 is a cosmetic or pharmaceutical composition comprising an oil-containing biliquid foam dispersed in a salt-containing aqueous phase, in which the aqueous phase, having a pH of less than about 7, comprising a polymeric sulfonic acid gellant.

The invention of claim 12 is a cosmetic or pharmaceutical composition comprising a silicone-oil containing biliquid foam dispersed in a salt-containing aqueous

phase, in which the aqueous phase, having a pH of less than about 7 and comprising an ammonium poly(acryldimethyltauramide-co-vinylformamide) gellant.

The invention of claim 19 is a method of thickening a composition comprising biliquid foam dispersed in a salt-containing aqueous phase having a pH less than about 7 comprising gelling the aqueous phase with a polymeric sulfonic acid.

### **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

The outstanding issue is whether Claims 1-21 are properly rejected under 35 U.S.C. §103(a) based on the references: Wheeler (WO 97/32559) (“Wheeler”) in view of the Clariant product (“Clariant”).

### **ARGUMENTS**

#### **I. Prosecution History**

This application is a continued prosecution application of a parent application, and was filed on May 16, 2003. A first rejection was mailed on July 21, 2003. The Office Action rejected claims 1-18 under novelty and 19-21 as obvious. After an amendment on October 20, 2003, the novelty rejection was withdrawn and claims 1-21 were finally rejected under an obviousness rejection in an office action dated January 30, 2004 under the references Wheeler and Clariant. The rejection of the claims, in pertinent part, was stated as follows:

The amended claim recites a pH of less than about 7 and this pH is less than 7; also, Wheeler teaches pH of 6.5 in example 3 and this pH is less than 7. Wheeler teaches Carbomer as a gellant but the secondary reference, Clariant product brochure, teaches polymeric sulfonic acid as gelling agent for systems such as the one disclosed by Wheeler and one gelling agent can be substituted for another and expect the gelling of the aqueous solution to take place. The declaration is not commensurate with the scope of the claims. Since the secondary reference teaches polymeric acid as a gellant, and since one gellant can be substituted for another, prediction or lack of prediction of the superiority of the polymeric sulfonic acid over the carbomer would not distinguish over the composition formed by substituting polymer sulfonic acid for carbomer since the same effect is obtained.

In response to this rejection, the Applicants submitted an after final amendment deleting the term “about” and again argued that the gellant of the present invention is unexpectedly superior to the use of any gellant based on two declarations, showing such results. Moreover, the Applicants submitted evidence that the claimed “stable” biliquid foam in Wheeler was in fact not stable at a pH below 7, exhibiting syneresis.

In an advisory action dated June 16, 2004, the Examiner maintained the final rejection of the claims, stating as follows:

The amendment to claims 1, 12 and 19 only deleted about so that the pH is now less than 7. This amendment does not change the claim and the prior art applied continues to be relevant. Applicants also argue that the declarations by Matathia and Harrison unequivocally demonstrate that the polymeric sulfonic acid gellants are unexpectedly superior in comparison to carbomers or several of the other gelling agents recited in Wheeler and that Examiner’s continued assertions that any gellant may be substituted for the gellants in Wheeler are completely unsupported (sic) in light of the evidence submitted by applicants as to the unexpected superiority of the Applicants’ claimed polymeric sulfonic acid gellants in gelling biliquid fo[a]m-containing aqueous dispersion to form a low pH (less than 7) stable product. Applicants further argue that Wheeler does not suggest a stable biliquid foam and that although Wheeler proposes a biliquid foam composition in example 3, the extremely large amount of surfactants (,50%) pr[e]sent in Wheeler takes the composition of Wheeler outside the definition of a biliquid foam as is known in the art (low levels of surfactant, i.e. less than about 1% surfactant). Applicants further state that example 3 of Wheeler would not be a stable biliquid foam with a pH of 6.5 without the excess of surfactant. Applicants’ argument is not persuasive. Applicants admit of stable biliquid foam in the example 3 of Wheeler. Wheeler discloses a composition at pH 6.5 in example 3 (applicants confirm). The instant composition does not exclude surfactants. Specifically, dependent claim 3 recites the presence of at least one surfactant. It is not until dependent claim 11 that there is a recitation of less tha[n] about 1%. This means that the generic claim which does not exclude surfactants and which does not recite the less than about 1% surfactant does not meet the argument for less than about 1% surfactant. The declaration is not commensurate with the scope of the claims.

It is noted that the after final amendment file don 07/30/04 does not comply with the format for amendments. Only amended claims 1, 12 and 19 were provided. The formant (sic) for amendment requires that a listing of all claims be provided, currently amended, previously amended, previously presented and original, all claims having respective status identifier must be presented in the amendment in the listing of the claims that would replace all prior versions of the claims.

Applicants subsequently filed a Notice of Appeal, and now present their arguments on appeal.

II. The rejection of all pending claims in the application is improper

For purposes of determining patentability, Claims 1 to 21, drawn to the sole issue of the present appeal, are grouped together and all grounds of rejection which Appellants contest apply these claims. Specifically, Claims 1 to 21 are grouped together as they apply to the grounds of rejection based on 35 U.S.C. §103(a). The present invention relates to a cosmetic or pharmaceutical composition comprising an oil-containing biliquid foam dispersed in a salt-containing aqueous phase, in which the aqueous phase, having a pH of less than about 7, comprising a polymeric sulfonic acid gellant. The gellant is an ammonium polyacryldimethyltauramide-co-vinylformamide. The cited references fail to teach or suggest the claimed biliquid foam composition containing the claimed gellant.

The basis of rejection of claims 1-21 under 35 U.S.C. §103(a) based on Wheeler and Clariant is incorrect both from a legal and a technical standpoint. As shown above in section I, the essence of the Examiner's position is that a person skilled in the art would be motivated to substitute the polymeric gellant of Clariant into the composition of Wheeler disclosing a carbomer as a gellant since one gellant may be substituted for another. The Examiner's position is inaccurate from a technical standpoint and incorrect from a legal standpoint.

The Appellants submit that the Examiner has failed to present a prima facie case of obviousness because all of the elements of the claims are not found either alone or in combination in the prior art cited. In establishing a prima facie case of obviousness, there must be a motivation or suggestion in the prior art other than from the Appellants' disclosure to combine the references. See In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). To once again briefly recap, the Appellants' invention as claimed is a cosmetic or pharmaceutical composition comprising an oil-containing biliquid foam dispersed in a salt-containing aqueous phase, in which the aqueous phase, having a pH of less than about 7, comprising a polymeric sulfonic acid gellant. In the after final amendment, the claims were amended to clarify the confusion

of the acidic nature of the composition, by deleting the term “about.” As a review, the Appellants’ invention is partially predicated on the fact that an acidic solution is necessary to allow the use of electrolytic acidic actives therein. A biliquid foam, as is described in the Appellant’s specification, in Wheeler’s specification, and as is well known in the art, is advantageous because it permits the incorporation of a relatively large quantity of oil and oil soluble actives into an aqueous phase with the use of a very small amount of surfactant. Also well known in the art is the fact that surfactants are used in large quantities in compositions to provide stability.

Wheeler, as is recognized by the Examiner, provides no teaching or suggestion for use of a polymeric sulfonic acid gellant. The Examiner’s continuous assertions that the polymeric sulfonic acid gellant disclosed in Clariant can be readily substituted into the composition of Wheeler based simply on the Examiner’s opinion that any gellant may be used, is not only mere conjecture, but has been scientifically proven to be incorrect by the Appellants. Moreover, the Appellants submit that the Examiner continued to ignore the ample evidence submitted by Appellants that there is no suggestion in either reference to substitute a polymeric sulfonic acid as a gellant for the carbomer in example 3 of Wheeler or for several of the other gelling agents recited in Wheeler (Matathia and Harrison Declarations). In essence, both Declarations unequivocally demonstrate that the polymeric sulfonic acid gellants are unexpectedly superior in comparison to carbomers or several of the other gelling agents recited in Wheeler. Therefore, the Examiner’s repeated assertions that any gellant may be substituted for the gellants in Wheeler are completely unsupported in light of the evidence submitted by Applicants as to the unexpected superiority of the Applicants’ claimed polymeric sulfonic acid gellants in gelling a biliquid foam-containing aqueous dispersion to form a low pH (less than 7) stable product. It is well established law that evidence of unexpected results is evidence of nonobviousness in order to rebut an obviousness rejection. See eg., In re Soni, 54 F.3d 746, 34 USPQ2d 1684 (Fed. Cir. 1995) ([W]hen an applicant demonstrates substantially improved results, as Soni did here, and states that the results were unexpected, this should suffice to establish unexpected results in the absence of evidence to the contrary). The Appellants therefore submit that the rejection by the Examiner has no technical or legal basis and should be withdrawn.

The further argument that a stable biliquid foam with a pH of less than 7 is not even taught in Wheeler was provided simply as further support for the nonobviousness of the Appellants' invention, showing that each and every element of the claimed invention could not be provided by the combination of the cited references. However, Appellants again emphasize that without a suggestion for the substitution of the polymeric sulfonic acid gellant into Wheeler, for which none exists in the prior art cited, the obviousness rejection is completely improper. Appellants continue to submit that Wheeler, which claims to have a stable biliquid foam composition in example 3 with a pH of 6.5, in fact does not, according to the Declaration already submitted to the Examiner, which Examiner continually ignored. First, the extremely large amount of surfactants (>50%) present in that composition takes the composition outside the definition of a biliquid foam as is known in the art (low levels of surfactant) and as is taught in the present invention (less than about 1% surfactant). Although claim 1 of the present invention does not limit the amount of surfactant, the terms of the claims are interpreted by the definitions commonly used in the art. Therefore, the biliquid foam of the Appellants' claim 1 would naturally be interpreted to have low levels of surfactant. On the other hand, Wheeler's example 3 has been proven to be false, as shown in the Appellants' Harrison Declaration, submitted to the Examiner. Specifically, the test results in the Harrison Declaration showed that a composition as is taught in Wheeler with a pH of 5.5 (pH below 7, as is required by the present claims), exhibited syneresis and was therefore unstable (Declaration, pp. 2-3). Therefore, Wheeler does not teach a stable biliquid foam composition with a pH of less than 7, and therefore would not lead a person of ordinary skill in the art to find a means of providing a stable biliquid foam dispersed in an aqueous phase having a pH less than 7 without the benefit of Applicant's own disclosure.

Moreover, Examiner's argument that Applicants do not exclude the presence of surfactants in the claims is irrelevant since the Applicants are not trying to claim a difference in the two compositions based on the amount of surfactant used or that the polymeric sulfonic acid would not gel the composition claimed in Wheeler. Instead, the Applicants argue that without the benefit of Applicants' disclosure, and therefore hindsight reconstruction, a person skilled in the art would not be motivated to substitute the gellants in Wheeler with the polymeric sulfonic acid gellant in Clariant since the

polymeric sulfonic acid gellant is unexpectedly superior to other gellants suggested in Wheeler. See In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1780, 1783 (Fed. Cir. 1988) ("cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.").

The Appellants therefore again submit that Wheeler does not teach or suggest the use of a polymeric sulfonic acid gellant, nor a stable biliquid foam dispersed in an aqueous phase having a pH of less than 7 and Clariant does not supply this deficiency. Therefore, it would not be obvious to make the substitution of the a polymeric sulfonic acid gellant in Wheeler's composition when such a gellant is not even suggested in the lists of gellants provided in Wheeler and since such a gellant creates an unexpectedly superior product, thereby rendering the gellant as a nonobvious substitution. The mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680 (Fed. Cir. 1990).

## **CONCLUSION**

In light of the arguments presented above, the obviousness rejection of Claims 1 to 21 should be reversed as they are unfounded and they are based on Examiner's personal opinion and on hindsight reconstruction. Accordingly, Appellants respectfully request that the Honorable Board reverse the decision of the Examiner finally rejecting the pending claims and declare that all pending claims in this application are allowable.

Respectfully submitted,

/Radha Masilamani/

Mekalaradha Masilamani,



Reg. No. 46,154  
Estée Lauder Companies  
155 Pinelawn Road  
Melville, NY 11747  
(631) 414-6089

## APPENDIX: THE CLAIMS ON APPEAL

1. (currently amended) A cosmetic or pharmaceutical composition comprising an oil-containing biliquid foam dispersed in a salt-containing aqueous phase, in which the aqueous phase, having a pH of less than [about] 7, comprising a polymeric sulfonic acid gellant.
2. (original) The composition of claim 1 in which the polymeric sulfonic acid is ammonium poly(acryldimethyltauramide-co-vinylformamide).
3. (original) The composition of claim 1 in which the oil-containing biliquid foam comprises at least one oil, water and at least one surfactant.
4. (original) The composition of claim 1 in which the salt is derived from an alpha- or beta- hydroxy acid.
5. (original) The composition of claim 4 in which the acid is selected from the group consisting of lactic acid, malic acid, glycolic acid, citric acid, tartaric acid, and salicylic acid.
6. (original) The composition of claim 2 in which the gellant is present in an amount of about 1 to about 10% by weight of the total composition.
7. (original) The composition of claim 2 in which the oil phase gellant is present in an amount of about 1 to about 5% by weight of the total composition.
8. (original) The composition of claim 1 in which the biliquid foam contains a silicone oil.
9. (original) The composition of claim 1 in which the oil portion of the biliquid foam is present in an amount of from about 50 to about 90% by weight of the foam.

10. (original) The composition of claim 1 in which the biliquid foam comprises from about 30% to about 70% by weight of the total composition.

11. (original) The composition of claim 1 which comprises less than about 1% of surfactant.

12. (currently amended) A cosmetic or pharmaceutical composition comprising a silicone-oil containing biliquid foam dispersed in a salt-containing aqueous phase, in which the aqueous phase, having a pH of less than [about] 7 and comprising an ammonium poly(acryldimethyltauramide-co-vinylformamide) gellant.

13. (original) The composition of claim 12 in which the biliquid foam comprises at least one silicone oil, water and at least one surfactant.

14. (original) The composition of claim 12 in which the biliquid foam is present in an amount of from about 30 to about 70% by weight of the total composition.

15. (original) The composition of claim 12 in which the biliquid foam is present in an amount of from about 50 to about 90% by weight of the total composition.

16. (original) The composition of claim 12 in which the salt is derived from an alpha or beta hydroxyl acid.

17. (original) The composition of claim 12 which contains less than about 1% surfactant.

18. (original) The composition of claim 12 in which the gellant is present in an amount of from about 1 to about 10% by weight of the total composition.

19. (presently submitted) A method of thickening a composition comprising biliquid foam dispersed in a salt-containing aqueous phase having a pH less than [about] 7 comprising gelling the aqueous phase with a polymeric sulfonic acid.

20. (original) The method of claim 19 in which the gellant is ammonium poly(acryldimethyltauramide-co-vinylformamide).

21. (original) The method of claim 20 in which the gellant is present in amount of from about 1 to about 10% by weight of the total composition.

#### **EVIDENCE APPENDIX**

No evidence is presented.

#### **RELATED PROCEEDINGS APPENDIX**

There are no related proceedings or decisions.